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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,985	06/26/2001	Charles W. Paul	1935.PSA	9653

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EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,985

Applicant(s)

PAUL, CHARLES W

Examiner

Susan W Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Response to Amendment

Claim 7 has been amended to conform with the recitation “up to about 25% “of a rosin and/or rosin ester in the specification. Claim 11 has been added.

Response to Arguments

Applicant argues that one skilled in the art would know that a “rosin derived alcohol” is an alcohol derived from a rosin. However, applicant has not provided any evidence to support this allegation. There is no definition of “rosin derived alcohol” in the specification. The phrase can equally be interpreted to mean a rosin derived from an alcohol. It is not clear what the structure or method of preparation of the “rosin derived alcohol” employed in the instantly claimed invention is intended to be.

Applicant argues that the examiner appears to assume that “hydrogenated rosin” and “rosin derived alcohol” are the same thing. The assumption by the examiner is based on applicant’s statement on page 5 of the specification that “suitable rosin derived alcohols include hydrogenated rosin”. However, it is agreed that the statement can be interpreted to mean that the structure of the “rosin derived alcohol” “includes” a hydrogenated rosin structure and other structure. Applicant states that “ABITOL-E Resin is a high molecular weight primary monohydric alcohol derived from rosin acids that have been hydrogenated to reduce unsaturation. It is suggested that applicant provide trade literature to support this description of ABITOL-E at the time of the invention and incorporate this description into the instant specification to clarify the structure of the intended “rosin derived alcohols” as being alcohols derived from rosin acids.

The rejections of claims 1- 6 and 8-10 as being anticipated by Erickson (5,686,535) or Handlin, Jr. et al (5,446,104) are hereby withdrawn. Erickson et al ‘535 and Handlin, Jr. et al do not clearly disclose compositions containing a “rosin derived alcohol”. The rejections of claims over Ohtsuka et al (5,840,809) in view of Erickson et al ‘535, or Kiibler et al (5,691,414) or Southwick et al (5,776,998) each in view of Dillman et al (5,536,772) or Erickson (5,382,604 or 5,389,701) are withdrawn. The

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rejections over these references are withdrawn in order to simplify the issues because Dillman et al is considered to be the closest prior art.

The rejections of record over Erickson (5,382,604 or 5,389,701), Dillman et al and WO 01/29134 are maintained pending clarification of the phrase "rosin derived alcohol" supported by published art recognized definition or trade literature at the time of the invention.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what is meant by a "rosin derived alcohol" or rosin derived mono-ol. Does applicant intend to set forth an alcohol functional compound incorporating rosin moieties, a rosin incorporating alcohol moieties, a product obtained by reacting a rosin with an alcohol or a mono-ol or some other kind of structure? The name, structure or method of preparation of the "rosin derived alcohol" (or mono-ol) should be clearly set forth in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

With respect to each of the rejections set forth below, the examiner is interpreting “rosin derived alcohol” to encompass a derivative ester of rosin obtained by reacting rosin with an alcohol. Also applicant discloses on page 5 of the specification that suitable rosin derived alcohols include hydrogenated rosin. It is also noted that claims 1, 2, 4-6 and 8-10 encompass compositions that do not contain a “rosin derived alcohol”.

Claims 1, 2, 4- 6 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/29134. WO ‘134 discloses adhesive compositions comprising an epoxidized block copolymer, a diene-mono-ol polymer, a hydrogenated block copolymer of a vinyl aromatic hydrocarbon and a diene with a tackifying resin and a photoinitiator. See PSA and wt. percents in pages 13-14, photoinitiators on page 15, tackifying resins on page 17 and the Examples. WO ‘134 teach the species of the instantly claimed compositions comprising a saturated block copolymer, an epoxidized block copolymer and a cationic photoinitiator. Additional tackifiers may be added. Example 8 contains an oil. The rejected claims do not require the presence of a “rosin derived alcohol”.

Claims 1- 6 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by each of Erickson (5,382,604 or 5,389,701). Erickson ‘604 or ‘701 discloses compositions comprising an epoxidized diolefin block copolymer, cationic photoinitiators such as triarylsulfonium salts, and adhesion promoting or tackifying resins and compounding oils. The tackifying resins include diene-olefin copolymers, hydrogenated rosin, esters of rosins, terpenes and arene-block compatible resins. See US

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'604: column 8, lines 51-63, column 10, line 21, to column 11, line 18. Erickson anticipates the instantly claimed compositions containing a saturated block copolymer and optionally containing a rosin derived alcohol.

Claims 1- 6 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by each of Dillman et al (5,536,772). Dillman et al teach addition of esters of rosins, end block reinforcing resins, such as polystyrene resins, terpene tackifying resins, compounding oils. See the Abstract, column 3, lines 21-31, column 8, lines 10-20, column 8, line 40, to column 9, line 54, column 10, line 61, to column 11, line 14. Dillman et al teach that hydrogenated rosins, esters of rosin and other rosin materials , as taught by Udipti et al (US 4,135,037), are very compatible with epoxidized diene polymers but that they interfere with radiation crosslinking (column 8, line 56, to column 9, line 2). Dillman et al anticipate the instantly claimed compositions containing a saturated block copolymer and/or a "rosin derived alcohol". Dillman et al also anticipate the instantly claimed compositions containing a "rosin derived alcohol" because the disclosure of Udipti et al is incorporated into Dillman et al in column 8, lines 59-60, for teaching hydrogenated rosins, esters of rosin and other rosin materials are very compatible with epoxidized diene polymers. The rosins disclosed by Udipti et al include modified rosins with alcohols and polyols (column 2, lines 60-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1- 6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillman et al (5,536,772) alone or in view of Udipi et al (4,135,037).

Dillman et al teach addition of rosins, end block reinforcing resins, such as polystyrene resins, terpene tackifying resins, and compounding oils. See the Abstract, column 3, lines 21-31, column 8, lines 10-20, column 8, line 40, to column 9, line 54, column 10, line 61, to column 11, line 14 Dillman et al teach that hydrogenated rosins, esters of rosin and other rosin materials are very compatible with epoxidized diene polymers but that they interfere with radiation crosslinking (column 8, line 56, to column 9, line 2). The disclosure of Udipi et al is incorporated into Dillman et al in column 8, lines 59-60, for teaching hydrogenated rosins, esters of rosin and other rosin materials are very compatible with epoxidized diene polymers. The rosins disclosed by Udipi et al include modified rosins with alcohols and polyols (column 2, lines 60-67).

It would have been obvious to one skilled in the art at the time of the invention to employ modified rosins with alcohols or polyols, as taught by Udipi et al and incorporated by reference into Dillman et al, as the rosin tackifying material in the compositions disclosed by Dillman et al because Dillman et al teach that the tackifying resin can be "other rosin materials" such as disclosed by Udipi et al. Udipi et al and Dillman et al each provide motivation to select rosin materials by teaching that the rosins are very compatible with epoxidized diene polymers.

Allowable Subject Matter

Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Compositions comprising each of the components set forth in claim 7 in the recited weight percents are not suggested by the prior art cited herein.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman
Primary Examiner
Art Unit 1711

SB
May 25, 2003